

REMARKS

This paper responds to the most recent Office action, which was non-final.

Claims 1-8 stand rejected under 35 USC 102 as being anticipated by Skene, U.S. Publication No. 2001/0052016, which the Examiner contends has an effective filing date of February 16, 2000, based on Serial No. 60/182,812. The Examiner is correct that the publication is entitled to the earlier priority date, however, this entitlement extends only to the subject matter actually disclosed in the provisional application.

The provisional application (Serial No. 60/182,812) relates to a “method and system for name server load balancing” that “will load balance all name servers for content providers” (page A-1). As described on page A-2, a “client’s local name server (LDNS) makes requests to an authoritative name server (DNS) for a zone. This is the first opportunity to examine the network conditions and then distribute traffic appropriately.” Page A-3 at top illustrates a sample zone file configuration for subdomain.domain.com. This zone has several name servers associated to it. The content for the domain (www) apparently is associated with one of several content servers (vs0-4). Section B of the document describes a set of requirements for “Name Server Load Balance for CDN” with similar details as those described on pages A-1 and A-2. At pages B-4 and B-5, the authors identify the inclusion of “Metrics enhancements and BGP Support” apparently for the purpose of “identifying the proximity of the resolution request and directing the request to the closest geographic RE-SERVER, the best quality path, or the best performing RE-SERVER.” The “RE-SERVER” is not defined specifically. Whether this is a reference to a name server, a content server, or some other type of server, is unknown. Pages B-5 through B-7 describe how the system associates “regions” with IP addresses. A region “will consist of a name, geographic attributes, and CIDR definitions that make up the IP addresses that could reside in that location.” Page B-7 discloses a representative mapping between wide area network IP pools and regions “such that traffic can be [guided] to that region when a requesting IP address is identified.”

Alleged anticipation requires exact correspondence between a subject claim and the teaching of the reference. *Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed.Cir. 2008) (“unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed”). The

Manual of Patent Examining Procedure (MPEP) § 2131, likewise, provides that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. ... ‘The identical invention must be shown in as complete detail as contained in the ... claim.’” Although the literal wording need not be found in the reference, the elements must be arranged as required by the claim.

The claimed subject matter must be disclosed “clearly and unequivocally” in the reference. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972). Moreover, anticipation is not established if, in reading a claim on something disclosed in a reference, it is necessary to pick, choose and combine various portions of the disclosure, which according to the teachings of the reference, are not directly related to each other. *Id.*, 455 F.2d at 587-88.

The prior art reference must describe every limitation in a claim either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Inherent anticipation, however, cannot be based on possibilities or probabilities. *Akamai Tech., Inc. v. Cable & Wireless Internet Serv., Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003) (“A claim limitation is inherent in the prior art only if it is necessarily present in the prior art, not merely probably or possibly present.”); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (“Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art”).

Further, to be anticipatory, the reference must “enable one of ordinary skill in the art to make the invention without undue experimentation.” *Impax Labs., Inc. v. Aventis Pharms. Inc.*, 545 F.3d 1312, 1314 (Fed. Cir. 2008); see *In re Paulson*, 30 F.3d 1475, 1478-1479 (Fed.Cir. 1994); *In re LeGrice*, 301 F.2d 929, 940-44 (CCPA 1962).

“Absence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed.Cir.1986).

The provisional application described above is not enabling for purposes of alleged anticipation. In particular, there is no disclosure about how to use the identified tools and data identified to generate the zone file or server pool associations (page A-3) or the IP pools-to-region mapping (page B-7). Indeed, the authors note (with candor) at page B-2 that there are “issues that require further investigation.” They do not define various terms, such as RE-SERVER. The provisional application does not include any processes, any algorithms, or any methods for determining how the “client local name server” should be associated with the other

name servers – in other words, how the actual “selecting” takes place. While the provisional makes passing references to using the “closest geographic RE-SERVER, the best quality path, or the best performing RE-SERVER”, how this is accomplished is completely absent from the four (4) corners of the document itself. (Moreover, it is not proper to attempt to fill in those gaps with the more detailed teachings in U.S. Publication No. 2001/0052016, as the later-added disclosure is only subject to the February 16, 2001 filing date (not the provisional application filing date).

Claim 1 includes the following subject matter positively recited that is not explicitly taught by the provisional application:

“for each Internet Protocol (IP) address block from which requests for content resources are expected to be received, generating a candidate list of Internet data centers to be used to service the requests for content resources, wherein the candidate list of Internet data centers is generated using (i) geographic information from one or more Internet registry databases identifying a geographic location of the IP address block, (ii) BGP route information collected from BGP peers participating in BGP (BGP) sessions, (iii) autonomous system (AS) information, and (iv) data collected from one or more network performance metric tests; and;
for the IP address block, selecting at least one of the Internet data centers from the candidate list to be used to service the requests for content resources, wherein the selected Internet data center is written into a network map.”

For this reason alone, the anticipation rejection was improper and should be withdrawn. Nevertheless, to advance this lengthy prosecution to a close, the “selecting” step has been described now in more detail, namely:

“wherein the selecting step is carried out concurrently for each IP address block from which requests for content resources are expected to be received such that the network map comprises the selected Internet data center for each IP address block.”

Thus, as now amended, the “selecting step” is carried out concurrently for all of the IP address blocks “from which requests for content resources are expected to be received.” In the preferred embodiment, the selection takes advantage of an algorithm such as the one described in [0078] of the disclosure, although this technique is not limiting.

Given the strict standard required to establish anticipation, the Examiner is asked to reconsider the pending rejection and allow the claims, as the provisional application itself does not teach this subject matter explicitly, and the subject matter is not necessarily present within

the provisional either. Further, and for the reasons stated, the provisional (in of itself) is non-enabling and thus cannot be the basis of an anticipation.

Dependent claims 2-8 are patentable for the same reasons advanced with respect to claim 1. Reconsideration is requested, and the undersigned is prepared to work with the Examiner if he believes further issues still need to be addressed.

Respectfully submitted,

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